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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,883	11/21/2000	Susana Salceda	DEX-0115	2018
26259	7590	01/13/2004	EXAMINER	
LICATLA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053			YU, MISOOK	
			ART UNIT	PAPER NUMBER
			1642	24

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/717,883

Applicant(s)

SALCEDA ET AL.

Examiner

MISOOK YU, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 24.                      6) ☐ Other:

### DETAILED ACTION

Claim 3 is pending and under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

#### *Allowable Subject Matter*

On reconsideration, the indicated allowability of claim 3 is withdrawn. See the rejections below.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is newly rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites "under stringent conditions" but it is not clear what the metes and bounds are. The specification does not define the stringent conditions.

The rejection of claim 3 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement **is reinstated**. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. On close re-examination of claim 3 along with the specification at page 6 lines 13-21, the Office interprets that the claim is

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not limited SEQ ID NO:1. This rejection is based on the limitation "Ovr107 comprises...a polynucleotide which hybridizes under stringent conditions to the antisense sequence of SEQ ID NO:1". There is a lack of written description for Ovr107 comprise a polynucleotide which hybridizes under stringent conditions to the antisense sequence of SEQ ID NO:1. The claims are interpreted as drawn to cancer diagnosis method by detecting **a genus of nucleotides molecules** that are defined only by hybridization under stringent condition.

To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present in the claim is hybridization under stringent conditions to SEQ ID NO:1. There is not even identification of any particular portion of the structure that must be conserved in order to be overexpressed in various cancers. Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus.

*Vas-Cath Inc. v. Mahurkar*, 19USPQ2d 1111, clearly states "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The

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specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116). As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of nucleotides molecules, given that the specification has only described SEQ ID NO: 1. Therefore, only nucleotides molecule comprising SEQ ID NO: 1, but not the full breadth of the claim meets the written description provision of 35 U.S.C. §112, first paragraph. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. §112 is separable from its enablement provision (see page 1115). A definition by function alone "does not suffice, to sufficiently describe a coding sequence "because it is only an indication of what the gene does, rather than what it is." *Eli Lilly*, 119 F.3 at 1568, 43 USPQ2d at 1406.

This rejection would be obviate by limiting the scope to SEQ ID NO:1.

Claim 3 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for detection in cells and tissue sample, does not reasonably provide enablement for **bodily fluids**. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. This rejection is based on the interpretation of the claim is drawn to method of diagnosing cancer by detecting increased level of SEQ ID NO:1 in **bodily fluids** from a patient. The specification at Table 2 (page 21-30 discloses higher expression of SEQ ID NO:1 in tissues from ovarian, lung, endometrium cancer and also how to detect such expression using the

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disclosed probes at page 20 lines 15-17. However, the specification does not teach whether the nucleic acid molecule is also detected in bodily fluids. The limitation bodily fluid suggests that somehow the nucleic acid find its way into the circulation or outside of cells. If leaked out of cell, then it is not clear whether the overexpression could be detected using the same probes for tissue samples.

Bast et al (BA of IDS filed on 08/01/2003, Clin. Chem. 1993) teach at page 247-8 that antigens in cancer cells find its way into circulation. However, the art as whole do not teach a nucleic acid overexpression would be detected in bodily fluid.

Considering the state of art, limited guidance in the specification, and no working example in specification, undue experimentation involving a large number of clinical samples would be required to in order to practice the full scope of the claim.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu  
January 6, 2004

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